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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,198	06/20/2001	Augustin T. Chen	393325	5726

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EXAMINER

SASTRI, SATYA B

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/885,198

Applicant(s)

CHEN ET AL.

Examiner

Satya B Sastri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22,24,27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22,24,27 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 16, 2004 has been entered. *Claims 22, 24, 27 and 29* are now pending in the application.

#### *Claim Rejections - 35 USC § 102/103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 22 and 27* are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al. (US 5,514,122), *or in the alternative, under 35 u.s.c. 103(a) as obvious over Morris et. al.*

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Morris et al. disclose pressure-sensitive adhesive compositions comprising matrix or binder and polymeric microspheres. The polymeric microspheres are based on polymerizable monomers selected from the group of alkyl acrylate esters, alkyl methacrylate esters etc. (column 4, lines 10-11). The matrix or binder is based on free radically polymerizable acrylate such as isooctyl acrylate, isononyl acrylate, n-butyl acrylate, hexyl acrylate etc. (column 6, lines 42-53). The disclosure further includes that for obtaining superior cohesive strengths, the adhesive matrix may be crosslinked with multiacrylates (column 7, lines 46-51). The adhesive may comprise 1 to 60 parts of a water dispersible acrylate microsphere and 99 to 40 parts of aqueous latex as adhesive matrix (column 15, lines 39-58, claim 1). Additionally, in working examples 1-7 in column 10 for adhesive preparation, an aqueous microsphere suspension of 25% solids by weight or 49% solids by weight is blended with latex adhesive in amounts appropriate to provide the desired weight % of microspheres on a dry basis. In this prior art, the weight ratio, on a solids basis, of microspheres to crosslinked acrylate polymer ranges from about 0.04:1 to about 2:1 (column 11, Table I). Morris et al. disclose a disposable absorbent article which comprises a liquid permeable cover layer, an absorbent layer and a liquid impermeable backing layer and a linerless adhesive fastening region on at least one face of said backing layer comprising the adhesive composition (column 15, lines 40-59). The present invention includes microspheres made by a specific process but the final product made by the process reads on the prior art composition. Where product by process claims are rejected over a prior art product, the burden is shifted to applicants to establish unobvious difference, even if production processes are different unless applicants show criticality of the process involved. *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

5. *Claims 24 and 29* are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morris et al. (US 5,514,122).

The disclosure of Morris et al. is adequately set forth in paragraph 5 and is incorporated herein by reference. The present claims are based on the composition of the pressure sensitive adhesive and an article based on the same and both read on prior art composition to Morris et al. Given the similarity in the compositions, a reasonable basis exists to believe that the adhesive composition must inherently have a peel force within the claimed range. It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594, 596 (CCPA 1980).

#### ***Response to Arguments***

6. Applicants argue that the present invention is in regard to an aqueous adhesive whereas the prior art to Morris et al. (US 5,514,122) teaches a disposable absorbent article having hollow polymeric microspheres produced using a non-free radically polymerizable acid. Firstly, Morris et al. disclose pressure-sensitive adhesive compositions comprising matrix or binder and

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polymeric microspheres and a disposable absorbent article comprising the adhesive.

Additionally, the art disclosure does not exclude solid polymeric microspheres in the adhesive compositions and teaches that solid microspheres may be prepared by a "one-step" emulsification process comprising an aqueous suspension polymerization of the free radically polymerizable monomer(s), at least one hydrophilizing component, an emulsifier or suspension stabilizers, optionally at least one polar monomer, oil soluble initiator(s), optionally crosslinkers, and other optional additives in an aqueous or other polar solution. Methods for suspension polymerization include these described in patents such as U.S. Pat. Nos. 3,620,988; 4,166,152; 4,495,318; 4,598,112; 4,810,763; DE 3,544,882; 4,786,696 or 4,645,783. The suspension can be stabilized by polymeric stabilizers, include those described in U.S. Pat. No. 4,166,152 (Baker et al., including but not limited to casein, crosslinked polyacrylic acids, polyoxyethylene, polyacrylic acid, polymethacrylic acid, polyacrylamide, polyvinyl pyrrolidone, polyethylene amine, polyvinyl methyl ether, polyvinyl alcohol, salts thereof, and mixtures thereof). Polymeric stabilizers or mechanical agitation can be used alone or in conjunction with ionic or nonionic surfactants or emulsifiers. Preferred are suspension polymerization processes using ionic or nonionic emulsifiers at a concentration greater than the critical micelle concentration (column 4, lines 58-68 and column 5, lines 1-12).

In summary, the prior art teaches the process of making solid microspheres and admits the same as known prior art. The following issues have not been addressed unambiguously in the instant product by process claims and the inherent properties of the product. Firstly, it is unclear how the non-free radically polymerizable acid alters the composition of the solid microspheres. Secondly, the prior art clearly recognizes the usage of solid microspheres made

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by the processes disclosed in the incorporated references. Thirdly, applicants' have not proved how the prior art methods yield a different product as compared to the process of the instant invention. Unexpected results are sought for the patentability of this application.

*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 212 1112.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 212 1114.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*satya sastri*

SATYA SASTRI

September 28, 2004

**TATYANA ZALUKAEVA**  
**PRIMARY EXAMINER**

*Tzalukif*